

Claims 32-33 are newly added. Support for new claims 32-33 is found throughout the application as filed. More particularly, support is found, for example, on page 14, lines 11-22 and Table 1, page 16, first four entries.

No new matter has been introduced with the foregoing amendment and newly added claims.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

II. DOUBLE PATENTING REJECTION

Claims 1-9 and 14-23 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being obvious over claims 1-4 of U.S. Patent No. 6,319,724 ("724 patent," Lewis *et al.*) in view of U.S. Patent No. 6,244,096 ("096 patent," Lewis *et al.*). In order to expedite prosecution of the above-referenced application, claims 1-9 and 14-23 have been canceled without prejudice, thus rendering the rejection moot. As such, Applicants respectfully request that the double patenting rejection be withdrawn.

III. FIRST REJECTION UNDER 35 U.S.C. § 102(e)

Claims 1-4, 24, 26, 27, 29 and 30 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,170,318 ("Lewis *et al.*"). According to the Office Action, Lewis *et al.* teach methods for using fluid detection devices, including detection of a wide variety of compounds by resistively sensing the presence of the analyte compound in a fluid. To the extent that the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection. In order to expedite prosecution of the above-referenced application, claims 1-4 have been canceled without prejudice, thus rendering the rejection with respect to claims 1-4 moot.

Further, U.S. Patent No. 6,170,318 matured from a continuation-in-part application, *i.e.*, U.S. Patent Application No. 09/183,724, which was filed on October 30, 1998. The present application claims priority to U.S. Provisional Patent Applications filed on June 19, 1998 and June 30, 1998, which is prior to the filing date of U.S. Patent Application No. 09/183,724.

Applicants believe that subject matter added to U.S. Patent Application No. 09/183,724, which is new to the October 30, 1998 filing date, is not prior art to the subject matter in the present application that finds support in the earlier filed provisional applications.

However, in any event, the present claims are drawn to an invention wherein data is stored so that multiple samples over a period of time may be taken. This permits a baseline to be established for a particular patient, and trend analysis can be performed on the resulting data. If there is a change in the condition of the patient's breath, indications of this change may be sent by communication for example, to a physician or healthcare provider. The output from the sensors would be stored with the data obtained from the breath analysis and might also be used to determine if a particular change in breath components were significant.

Under 35 U.S.C. § 102(e), each and every element of the challenged claim must be present in the cited art. Since U.S. Patent No. 6,170,318 does not teach each and every element of the challenged claim, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be withdrawn.

IV. SECOND REJECTION UNDER 35 U.S.C. § 102(e)

Claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,057,162 ("Rounbehler *et al.*"). In order to expedite prosecution, Applicants have canceled claims 1-3 without prejudice, thus rendering the rejection moot.

As such, Applicants respectfully request that the rejection be withdrawn.

V. REJECTIONS UNDER 35 § U.S.C. 103(a)

Claims 25 and 31 were rejected under 35 § U.S.C. 103(a) as allegedly being obvious over U.S. Patent No. 6,170,318 (“Lewis *et al.*”). The Examiner acknowledges that Lewis *et al.* do not teach the formation of a breath database by repetitive sampling. To the extent that the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

Claim 25 has been canceled without prejudice, thus rendering the rejection moot with respect to this claim. As such, Applicants respectfully request that the Examiner withdraw the rejection.

Further, U.S. Patent No. 6,170,318 matured from a continuation-in-part application, *i.e.*, U.S. Patent Application No. 09/183,724, which was filed on October 30, 1998. The present application claims priority to U.S. Provisional Patent Applications filed on June 19, 1998 and June 30, 1998, which is prior to the filing date of U.S. Patent Application No. 09/183,724.

In any event, for a proper rejection under 35 U.S.C. § 103(a) the cited art reference must teach or suggest all the limitations of the claims. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Applicants assert that the cited art reference does not teach or suggest all the limitations of the claims. Under *In re Wilson supra*, a *prima facie* case of obviousness has not been established because each of the limitation of the claims is not taught or suggested in the cited art reference. As such, Applicants respectfully request that the Examiner withdraw the rejection.

Claim 4 was rejected under 35 § U.S.C. 103(a) as allegedly being obvious over Rounbehler *et al.* in view PCT Application No. WO 95/33848, “Payne *et al.*”. To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

Claim 4 has been canceled thus rendering this rejection moot. As such, Applicants respectfully request that the Examiner withdraw the rejection.

Claims 6-8 were rejected under 35 § U.S.C. 103(a) as allegedly being obvious over Rounbehler *et al.* in view of other prior art references. Claims 4-6 have been canceled thus rendering this rejection moot. As such, Applicants respectfully request that the Examiner withdraw the rejection.

Claim 9 was rejected under 35 § U.S.C. 103(a) as allegedly being obvious over Rounbehler *et al.* in view of prior art references and further in view of Payne *et al.* Claim 9 has been canceled thus rendering this rejection moot. As such, Applicants respectfully request that the Examiner withdraw the rejection.

Claims 18-21 were rejected under 35 § U.S.C. 103(a) as allegedly being obvious over U.S. Patent No. 5,571,401 ("Lewis *et al.*") in view of Cutler *et al.*

Claims 18-21 have been canceled thus rendering this rejection moot. As such, Applicants respectfully request that the Examiner withdraw the rejection.

Claims 14-17 were rejected under 35 § U.S.C. 103(a) as allegedly being obvious over U.S. Patent No. 5,571,401 ("Lewis *et al.*") in view of other prior art. Claims 14-17 have been canceled thus rendering this rejection moot. As such, Applicants respectfully request that the Examiner withdraw the rejection.

As such, Applicants respectfully request that all the rejections under 35 § U.S.C. 103(a) be withdrawn.

VI. CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



Joseph R. Snyder
Reg. No. 39,381

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
JS:slw
WC 9042945 v1

VERSION WITH MARKINGS TO SHOW CHANGES MADE

24. (Once Amended) A method for comparing the analyte profiles of mammalian breath samples, said method comprising:

(a) contacting an array of sensors with a first sample of mammalian breath to identify analytes in said first sample;

(b) storing the results of the analysis of said first sample in a computer-readable format;

(c) contacting an array of sensors with a second sample of mammalian breath to identify analytes in said second sample; and

(d) comparing the results of the analysis of said second sample with the stored results of the analysis of said first sample [with a stored mammalian breath analyte profile], thereby comparing the analyte profiles of mammalian breath samples.